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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,896	10/15/2001	Cheol-Woong Lee	042933/253085	3473
826	7590	03/02/2007	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			POPHAM, JEFFREY D	
			ART UNIT	PAPER NUMBER
			2137	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/02/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/977,896	LEE ET AL.
	Examiner	Art Unit
	Jeffrey D. Popham	2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 December 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**GUY LAMARRE**  
**PRIMARY EXAMINER**

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 15 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Remarks***

Claims 1-18 are pending.

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Objections***

2. Claim 17 is objected to because of the following informalities: there is no "modifying" step in either of claims 1 or 3, therefore recitation of "wherein modifying the digital music file comprises" lacks antecedent basis. For purposes of prior art rejection, claim 3 has been construed as being dependent upon claim 13 instead of claim 3.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanning (U.S. Patent 6,366,907) in view of Hale (U.S. Patent 6,732,180).

Regarding Claim 12,

Fanning discloses a method comprising:

Searching a network for a digital music file (Column 3, line 33 to Column 4, line 19);

Identifying a plurality of digital music files that are substantially similar to the digital music file (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); and

Collecting one of the plurality of digital music files that has a greatest number of files having the same name, size and playing time (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7);

But does not explicitly disclose modifying the collected file and redistributing the modified file.

Hale, however, discloses preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network by searching a network for an illegally produced digital music file, which is derived from a record of a cooperating record corporation (Column 6, lines 44-56; and Column 7, lines 24-67); identifying a plurality of digital music files that are substantially similar to the illegally produced digital music file (Column 7, line 24 to Column 8, line 37); selecting one of the plurality of digital music files that has a greatest number of files having the same name, size and playing time (Column 7, line 24 to Column 8, line 37); modifying the collected digital music file

(Column 8, lines 1-37); and redistributing the modified digital music file through the network (Column 8, line 38 to Column 9, line 32). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the rights protection system of Hale into the real-time searching system of Fanning in order to inhibit and deter unauthorized users to proprietary media, while leaving legitimate files unaffected, thereby rendering the use of media brokering systems ineffective, such that users will be less likely to use such systems for illegal purposes.

Regarding Claim 13,

Fanning as modified by Hale discloses the method of claim 12, in addition, Fanning discloses that searching the network for the illegally produced digital music file comprises searching the network according to a kind of music of the digital music file (Column 3, line 33 to Column 4, line 19).

Regarding Claim 14,

Fanning as modified by Hale discloses the method of claim 12, in addition, Fanning discloses that the collecting is performed by using a popular digital file sharing server (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); and Hale discloses that collections, distributions, and redistributions are performed using a popular digital file sharing server (Column 10, line 42 to Column 11, line 26).

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Regarding Claim 18,

Fanning as modified by Hale discloses the method of claim 12, in addition, Hale discloses that modifying the collected digital music file comprises altering original content of the collected digital music file (Column 8, lines 1-37).

4. Claims 1-11 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanning in view of Hale, further in view of Yoshiura (U.S. Patent 6,499,105).

Regarding Claim 1,

Fanning discloses a method comprising collecting a digital music file according to a kind of music of the digital music file, by searching a network (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); but does not disclose that the digital music file is illegally produced and derived from a record of a cooperating record corporation, encrypting the collected digital music file with a predetermined key, and redistributing the encrypted digital music file through the network.

Hale, however, discloses preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network by selecting an illegally produced digital music file, which is derived from a record of a cooperating record corporation, by

searching the network (Column 7, line 24 to Column 8, line 37); modifying the digital music file (Column 8, lines 1-37); and redistributing the modified digital music file through the network (Column 8, line 38 to Column 9, line 32). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the rights protection system of Hale into the real-time searching system of Fanning in order to inhibit and deter unauthorized users to proprietary media, while leaving legitimate files unaffected, thereby rendering the use of media brokering systems ineffective, such that users will be less likely to use such systems for illegal purposes.

Yoshiura, however, discloses that modifying the digital music file comprises encrypting the digital music file with a predetermined key (Abstract; and Column 8, lines 34-67). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking and encryption schemes of Yoshiura into the real-time searching system of Fanning as modified by Hale in order to allow the system to encrypt the data such that only a user with the correct private key is able to decrypt the data, as well as to provide authenticatable digital data that can be traced back to the purchaser who purchased the content from which an illegal copy was produced.

Regarding Claim 2,

Fanning as modified by Hale and Yoshiura discloses the method of claim 1, in addition, Fanning discloses that the collecting is performed by using a popular digital file sharing program (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); and Hale discloses that collections, distributions, and redistributions are performed using a popular digital file sharing program (Column 10, line 42 to Column 11, line 26).

Regarding Claim 3,

Fanning as modified by Hale and Yoshiura discloses the method of claim 1, in addition, Fanning discloses that the collecting is performed by using a popular digital file sharing server (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); and Hale discloses that collections, distributions, and redistributions are performed using a popular digital file sharing server (Column 10, line 42 to Column 11, line 26).

Regarding Claim 4,

Yoshiura discloses that the collected digital music file is encrypted by a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Regarding Claim 5,

Yoshiura discloses that the collected digital music file is encrypted by a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Regarding Claim 6,

Yoshiura discloses that the collected digital music file is encrypted by a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Regarding Claim 7,

Fanning discloses a method comprising collecting a digital music file according to a kind of music of the digital music file, by searching a network (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); but does not disclose that the digital music file is illegally produced and derived from a record of a cooperating record corporation, inserting a watermark containing a predetermined secret information in the collected digital music file, and redistributing the watermarked digital music file through the network.

Hale, however, discloses preventing reduction of sales amount of records due to a digital music file illegally distributed through a communication network by selecting an illegally produced digital music file, which is derived from a record of a cooperating record corporation, by searching the network (Column 7, line 24 to Column 8, line 37); modifying the digital music file (Column 8, lines 1-37); and redistributing the modified

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digital music file through the network (Column 8, line 38 to Column 9, line 32). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the rights protection system of Hale into the real-time searching system of Fanning in order to inhibit and deter unauthorized users to proprietary media, while leaving legitimate files unaffected, thereby rendering the use of media brokering systems ineffective, such that users will be less likely to use such systems for illegal purposes.

Yoshiura, however, discloses inserting a watermark containing a predetermined secret information in the collected digital music file (Abstract; and Column 8, lines 34-67). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking and encryption schemes of Yoshiura into the real-time searching system of Fanning as modified by Hale in order to allow the system to encrypt the data such that only a user with the correct private key is able to decrypt the data, as well as to provide authenticatable digital data that can be traced back to the purchaser who purchased the content from which an illegal copy was produced.

Regarding Claim 8,

Fanning as modified by Hale and Yoshiura discloses the method of claim 7, in addition, Fanning discloses that the collecting is performed by using a popular digital file sharing program (Column 3, line 65 to Column

4, line 42; and Column 5, line 46 to Column 6, line 7); and Hale discloses that collections, distributions, and redistributions are performed using a popular digital file sharing program (Column 10, line 42 to Column 11, line 26).

Regarding Claim 9,

Fanning as modified by Hale and Yoshiura discloses the method of claim 7, in addition, Fanning discloses that the collecting is performed by using a popular digital file sharing server (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); and Hale discloses that collections, distributions, and redistributions are performed using a popular digital file sharing server (Column 10, line 42 to Column 11, line 26).

Regarding Claim 10,

Fanning as modified by Hale and Yoshiura discloses the method of claim 1, in addition, Fanning discloses that collecting the digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); and Hale discloses that selecting the illegally produced digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time (Column 7, line 24 to Column 8, line 37).

Regarding Claim 11,

Fanning as modified by Hale and Yoshiura discloses the method of claim 7, in addition, Fanning discloses that collecting the digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time (Column 3, line 65 to Column 4, line 42; and Column 5, line 46 to Column 6, line 7); and Hale discloses that selecting the illegally produced digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time (Column 7, line 24 to Column 8, line 37).

Regarding Claim 15,

Fanning as modified by Hale does not explicitly disclose that modifying the digital music file comprises encrypting the collected digital music file with a predetermined key.

Yoshiura, however, discloses that modifying the collected music file comprises encrypting the collected digital music file with a predetermined key (Abstract; and Column 8, lines 34-67). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking and encryption schemes of Yoshiura into the real-time searching system of Fanning as modified by Hale in order to allow the system to encrypt the data such that only a user with the correct private key is able to decrypt the data, as well as to provide authenticatable digital data that can be traced back to the purchaser who purchased the content from which an illegal copy was produced.

Regarding Claim 16,

Fanning as modified by Hale and Yoshiura discloses the method of claim 15, in addition, Yoshiura discloses that encrypting the collected digital music file comprises encrypting with a public key encryption algorithm (Abstract; and Column 8, lines 34-67).

Regarding Claim 17,

Fanning as modified by Hale discloses the method of claim 13, but does not disclose that modifying the collected digital music file comprises inserting a watermark containing a predetermined secret information in the collected digital music file.

Yoshiura, however, discloses that modifying the collected digital music file comprises inserting a watermark containing a predetermined secret information in the collected digital music file (Abstract; and Column 8, lines 34-67). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the watermarking and encryption schemes of Yoshiura into the real-time searching system of Fanning as modified by Hale in order to allow the system to encrypt the data such that only a user with the correct private key is able to decrypt the data, as well as to provide authenticatable digital data that can be traced back to the purchaser who purchased the content from which an illegal copy was produced.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D Popham  
Examiner  
Art Unit 2137